



Paper No. 16

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TECHNOLOGY LAW DEPARTMENT  
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OFFICE OF PETITIONS

In re Application of :  
Donovan et al. :  
Application No. 09/416,101 : DECISION DISMISSING PETITION  
Filed: October 12, 1999 : AS MOOT  
Attorney Docket No. RIC-99-027-DIV1 :  
:

This is a decision on the letter filed April 5, 2002, which is being treated as a petition under 37 CFR 1.181, requesting that a divisional patent application of prior application No. 09/416,101 be assigned an application number and accorded a filing date of June 25, 2001.

Petitioners allege that the original application papers were filed on June 25, 2001. In support, petitioners have supplied a copy of a stamped postcard receipt acknowledging receipt in the USPTO of, *inter alia*, a fee transmittal, "Continued Prosecution Application", 47 pages of specification, 13 sheets of drawings, a check for \$970.00, and a preliminary amendment. Petitioners state that the divisional application was inadvertently addressed to Box CPA rather than Box Patent Application. The petition was also accompanied by a "Utility Patent Application Transmittal" dated 4/5/02, a copy of a fee transmittal dated 6/25/01, a copy of a check for \$970.00 dated 6/22/01, a copy of a "Utility Patent Application Transmittal" dated 6/25/01, a copy of 47 pages of specification, a copy of 13 sheets of drawings, a copy of a preliminary amendment dated 6/25/01, a copy of a declaration and power of attorney, and a copy of Express Mail Receipt No. ET555404697US which is blank and unsigned.

The original application papers filed June 25, 2001 have been located in application No. 09/416,101. A review of the application papers filed on June 25, 2001, reveals that they were accompanied by a transmittal letter requesting a continued prosecution application (CPA) under 37 CFR 1.53(d) and by a "Utility Patent Application Transmittal" for an application under 37 CFR 1.53(b). If application papers are in any way designated as a CPA filing under 37 CFR 1.53(d), the application papers will be treated by the Office as a CPA filed under 37 CFR 1.53(d), even if the application papers also contain other inconsistent designations. See Manual of Patent Examining Procedure (MPEP), Section 201.06(d), page 200-43 (Eighth Edition, August 2001).

The CPA of June 25, 2001 was a proper CPA under 37 CFR 1.53(d) and was entitled to a filing date of June 25, 2001 as a CPA under 37 CFR 1.53(d). Accordingly, the CPA was entered and processed in application No. 09/416,101 and an Office action was mailed in the CPA on June 5, 2002.

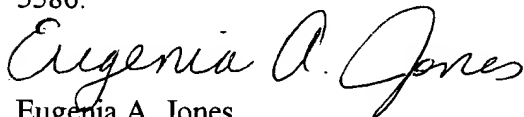
Furthermore, it is noted that a petition under 37 CFR 1.182 to disregard a previously filed request for a CPA and to treat the papers as a filing under 37 CFR 1.53(b) cannot be granted once the request for a CPA has been entered into the prior application and the request to expressly abandon the prior application has been acknowledged. If applicants intended to file a second application (either a continuation or a divisional) without abandoning the prior application, applicants can still achieve that result without loss of benefit of the original filing date by continuing the prosecution of the CPA and filing a new continuation or divisional application under 37 CFR 1.53(b) claiming the benefit of the CPA and its parent application under 35 U.S.C. 120 during the pendency of the CPA. See MPEP 201.06(d), page 200-42 (Eighth Edition, August 2001).

Since the original application papers have been located, the petition is dismissed as moot. No petition fee is required and none has been charged.

A request for continued examination (RCE) under 37 CFR 1.114 was filed on August 8, 2001. Since prosecution in the CPA is not closed, the RCE is improper. **The time period set forth in the Office action mailed June 5, 2002, continues to run.**

The application is being forwarded to Technology Center Art Unit 2664 for processing of the RCE filed August 8, 2001, as an improper RCE and to await any reply to the Office action mailed June 5, 2002.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 306-5586.



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